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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,515	12/09/2003	Marcin Sawicki	60001.295US01	3732
27488	7590	06/23/2008		
MERCHANT & GOULD (MICROSOFT)			EXAMINER	
P.O. BOX 2903			RIES, LAURIE ANNE	
MINNEAPOLIS, MN 55402-0903				
ART UNIT		PAPER NUMBER		
2176				
MAIL DATE		DELIVERY MODE		
06/23/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/731,515

**Applicant(s)**

SAWICKI ET AL.

**Examiner**

LAURIE RIES

**Art Unit**

2176

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 5-10, and 19-23 is/are allowed.
- 6) ☒ Claim(s) 3, 4 and 11-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 9/7/04.

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment, filed 4 February 2008, to the Original Application, filed 9 December 2003.
2. Claims 1, and 3-23 are pending. Claims 1, 11, and 19 are independent claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claims 3 and 4** are dependent upon claim 2, which has been cancelled. For the sake of further prosecution, it is assumed that claims 3 and 4 should be dependent upon claim 1.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 11-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Claims 11-18** are directed to a "computer-readable medium" that does not fall within a statutory category of invention, since the Instant Specification, at page 5, lines 13-14, describes the computer-readable media as including both "storage media" and "communication media". Additionally, the Instant Specification at page 5, lines 3-13, describe a "communication media" as including a signal. A signal, such as a modulated data signal, has no physical structure and does not itself perform any useful, concrete and tangible result. As such, claims 11-18 are ineligible for patent protection because they do not fall within any of the four statutory categories of invention as defined by 35 U.S.C. 101. The Office respectfully suggests the claims be amended to include only a computer-readable storage medium.

***Response to Arguments***

5. Applicant's arguments, see Amendment, filed 4 February 2008, with respect to the rejection of claims 1 and 3-23 under 35 U.S.C. 103(a) have been fully considered and are persuasive. The rejection of claims 1 and 3-23 under 35 U.S.C. 103(a) has been withdrawn.

***Allowable Subject Matter***

6. Claims 1, 5-10, and 19-23 are allowed.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is 571-272-4095. The examiner can normally be reached on M-F, 6:00am-3:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton, can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Laurie Ries/  
Patent Examiner  
Technology Center 2100  
17 June 2008